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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,236	03/13/2001	Douglas R. Deming	DD-2	2128
20808	7590	02/08/2005		
BROWN & MICHAELS, PC 400 M & T BANK BUILDING 118 NORTH TIOGA ST ITHACA, NY 14850			EXAMINER COLLINS, SCOTT M	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/805,236	Applicant(s) DEMING, DOUGLAS R.	
	Examiner Scott M. Collins	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Restriction Response on 10/04/2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11-19 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 and 25-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-5 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/13/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date <u>10/04/2004</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
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### DETAILED ACTION

1. Claims 1-5, 11-19, and 25-30 have been presented for examination.

#### *Election/Restrictions*

2. Applicant's election with traverse of Group I (claims 1-5 and 11-14) in the reply filed on 10/04/2004 is acknowledged. The traversal is on the ground(s) that the inventions are related and thus the burden on the Examiner is not great enough to justify a restriction requirement. This is not found persuasive because the claims in Group II (claims 15-19 and 25-30) include limitations regarding a financial instrument and a trading system that would not be found in class 709, let alone subclass 228.

The requirement is still deemed proper and is therefore made FINAL.

#### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5, 11-14, and 25-30 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, and 11-20 (respectively) of copending Application No. 09/805,235. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because the limitations of the present claims in the instant application provide no substantial difference from the limitations of the claims of the copending application. The limitations of the present claims in the instant application differ from the limitations of the claims of the copending application as they are directed to a method for capturing HTTP commands, whereas the copending claims are directed to computer program for performing the method for capturing HTTP commands. At the time the invention was made, it would have been obvious to a person of ordinary skill in the computing arts to construct a computer program to execute the steps of the claimed method in the instant application. One of ordinary skill in the art would have been motivated to do this because the execution of the method running on a computer system would require a computer program as claimed in the copending application. Similar reasoning applies to the system of claims 25-30 in the instant application as compared to the computer software program of claims 15-20 in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

***Claim Rejections - 35 USC § 112***

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6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 5 and 11-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The details of the TCP/IP Handler of claim 5 and the API method of claims 11-14 have not been taught in applicant's specification. It would take undue experimentation for one of ordinary skill in the art to determine the details of the TCP/IP Handler and the API. Applicant is reminded that no new matter is allowed in the amendment to the specification under 35 U.S.C. 132 AND 37 CFR 1.118 (a).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Procomm Plus. Procomm Plus was a very well known and widely used communications program which dated back to at least 1990. Procomm Plus had a record mode for recording the remote computer's prompts and the user's responses, e.g. like a log-on procedure, to create a source script file for compiling and using to automate that procedure by playing back the script

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(Procomm Plus page 122). Applicant's claimed invention is an obvious variation of Procomm Plus' recording mode and script playback because applicant's claimed invention also records the remote computer's prompts, the user's responses to it, and plays them back. It would have been obvious to one of ordinary skill in the networking art at the time of the invention that the claimed invention differed from the teachings of Procomm Plus only by a degree, e.g., being in the modem communication environment versus being in the web communication environment (HTTP is the web communication means). This is no more than a technician's skill to adapt an inventive concept from one technology environment to another technology environment since the inventive concept is the same. The inventive concept was taught by Procomm Plus, i.e. capturing the commands (via a script) used on log-on and the responses from the remote computer (server) and then replaying the captured commands in the script to automate the log-on procedure. Applicant described the same concept of recording and playback in the specification on pages 35-36 albeit in the web environment. However, this does not make it a new invention and it is no more than an adaptation of the well-known old techniques to the new environment.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Collins whose telephone number is 571.272.3934. The examiner can normally be reached on Mon.-Fri. 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B Harvey can be reached on 571.272.3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smc  
January 19, 2005

*V. Martin Wallace*  
V. Martin Wallace  
Supervisory Patent Examiner